

**REMARKS**

Claims 1-24 are pending. By this Amendment, claims 18, 22-24 have been cancelled without prejudice or disclaimer, claims 1 - 9, 11-12, 16-17 and 19-21 have been amended. No new matter is presented.

**Formal Matters**

The Office Action rejects claims 4, 6-8, 11, 16 and 22-23 under 35 U.S.C. §112, second paragraph. The claims have been amended responsive to the rejection. As such, applicant respectfully requests withdrawal of this rejection.

**Claims 1-17 and 19-21 Define Patentable Subject Matter**

A. The Office Action rejects claims 1-2 and 9 under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent 4,673,117 of Calton in view of U.S. Patent 5,649,658 of Hoffman et al. (Hoffman). Applicant respectfully traverses the rejection.

Applicant respectfully notes that Calton does not teach or suggest a flexible, soft-sided, insulated shell. On the contrary, Calton shows a rigid structure. In fact, Calton's Abstract describes the rigid structure by stating that "[t]he entire structure is strong enough to support the weight of a person, so that it doubles as a seat".

The Office Action alleges that Hoffman "suggest[s] providing two receptacles with an auxiliary pocket external to an insulated compartment". Applicant respectfully states that the applicant has been unable to find any reference in the Hoffman disclosure to such a suggestion of an insulated compartment. Accordingly, if there is

such a suggestion or reference, the applicant would appreciate the column and line numbers at which it appears so that a more informed argument can be made.

For a rejection under 35 U.S.C. §103(a), MPEP §706.02(j) requires the Patent Office to establish a *prima facie* case of obviousness using three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to have combined the referenced teachings; second, there must be a reasonable expectation of success; and third, the prior art references must teach or suggest all of the claim limitations. The teachings or suggestions to make the alleged combination and the reasonable expectation of success are to be found in the prior art and not based on the applicant's disclosure.

Accordingly, in addition to the discussion above, applicant respectfully notes that Calton makes reference to refreshments, notably beer. Furthermore, Hoffman is directed to a backpack having a portable change pad. The applicant respectfully submits that it is counter-intuitive to carry diapering materials in the same package with foodstuffs or beverages.

**A1. Claim 1**

Applicant respectfully submits that Calton or Hoffman, alone or in combination, fail to teach or suggest a flexible soft-sided insulated shell having an auxiliary pocket. Thus,

applicant respectfully submits that presently pending claim 1 is not obvious over the alleged Calton/Hoffman combination and is allowable.

**A2. Claim 2**

As discussed above, neither Calton or Hoffman, alone or in combination, teach or suggest a flexible, soft-sided insulated container, let alone such a container having a lifting member with a first mount operable to attach the pack to another object where the pack has a second mount to inhibit swaying of the pack relative to the another object to which the first mount is attached.

Accordingly, claim 2 is not obvious and is deemed allowable for the same reasons claim 1 is allowable, as well as for the additional subject matter recited therein.

**A3. Claim 9**

As discussed above, neither Calton or Hoffman, alone or in combination, teach or suggest a flexible, soft-sided insulated container, let alone such a container having an auxiliary compartment having a key holder mounted therein.

Accordingly, claim 9 is not obvious and is deemed allowable for the same reasons claims 1 is allowable, as well as for the additional subject matter recited therein.

As such, the applicant respectfully submits that the Office Action has not shown any suggestion or motivation in either of the references for their combination and/or modification, nor has it established a reasonable expectation of success.

Thus, applicant respectfully request withdrawal of this rejection.

**B.** The Office Action rejects claim 3 under 35 U.S.C. §103(a) as allegedly being unpatentable over Calton and Hoffman on the same basis as claim 1 above, and further in view of U.S. Patent 5,228,547 to Yoo and U.S. Patent 5,288,150 to Bearman. Applicant respectfully traverses the rejection.

As noted above regarding the rejection of claim 1, neither Calton or Hoffman, alone or in combination, teach or suggest a flexible, soft-sided insulated wall structure, let alone a pack having a see-through pocket mounted externally to the auxiliary compartment. Yoo is applied merely for providing a pocket 13 located on the external side of the auxiliary compartment for holding small items while Bearman is applied for merely suggesting providing a see-through pocket on a tote bag. Applicant respectfully submits that neither Yoo or Bearman overcomes the deficiencies of the alleged Calton/Hoffman combination. As such, applicant respectfully submits that claim 3 is not obvious and is deemed allowable for the same reasons as claim 1, in addition to the additional subject matter recited therein.

Applicant respectfully requests withdrawal of this rejection.

**C.** The Office Action rejects claims 4 and 11 under 35 U.S.C. §103(a) as allegedly being unpatentable over the alleged Calton/Hoffman combination applied above against claim 1, and further in view of U.S. Patent 4,378,866 to Pelavin and 5,288,150 to Bearman. Applicant respectfully traverses the rejection.

As discussed above in the remarks pertaining to claim 1, neither Calton or Hoffman, alone or in combination, teach or suggest a flexible, soft-sided insulated wall structure.

Pelavin is applied merely for suggesting a slanted pocket on a side portion of the container to store equipment therein while Bearman is applied for allegedly suggesting see-through pockets on a tote bag. Applicant respectfully submits that neither Pelavin or Bearman overcome the deficiencies of the alleged Calton/Hoffman combination. As such, applicant respectfully submits that claims 4 and 11 are not obvious and are deemed allowable for the same reasons as claim 1, in addition to the additional subject matter recited therein.

Applicant respectfully requests withdrawal of this rejection.

D. The Office Action rejects claim 5 under 35 U.S.C. §103(a) as allegedly being unpatentable over the alleged Calton/Hoffman combination as applied above against claim 1, and further in view of U.S. Patent 2,827,096 to Hinson and U.S. Patent 5,884,768 to Fox. Applicant respectfully traverses the rejection.

As discussed above in the remarks pertaining to claim 1, neither Calton or Hoffman, alone or in combination, teach or suggest a flexible, soft-sided insulated wall structure. Hinson is applied merely for suggesting an outer covering for the lid portion of a container while Fox is applied merely for showing a handle 17 on a lid portion of the container. Applicant respectfully submits that neither Hinson or Fox overcome the deficiencies of the alleged Calton/Hoffman combination. As such, applicant respectfully submits that claim 5 is not obvious and is deemed allowable for the same reasons as claim 1, in addition to the additional subject matter recited therein.

Applicant respectfully requests withdrawal of this rejection.

**E. The Office Action rejects claim 6 under 35 U.S.C. §103(a) as allegedly being unpatentable over the Calton/Hoffman/Hinson/Fox combination as applied against claims 1 and 5 above, and further in view of U.S. Patent 5,054,589 of Bomes. Applicant respectfully traverses the rejection.**

Bomes is applied for merely suggesting inner liners 52 within a container to store additional content therein. Applicant respectfully submits that Bomes fails to overcome the deficiencies of the alleged Calton/Hoffman/Hinson/Fox combination. Furthermore, applicant respectfully disagrees with the Office Action's characterization of Bomes item 52 as an invertible liner. It is not. Bomes describes item 52 as a "retaining flap" (see col. 3, lines 29 – 44). The retaining flap 52 has a mesh pocket. There is no illustration or suggestion that these retaining flaps can be inverted, i.e., turned inside out, or that there is any consideration that they be washable, or that they be impermeable. It would seem unlikely that a mesh pocket would be impermeable. Further still, the Office Action has provided no substantive justification for the combination of five separate references. As such, applicant respectfully submits that claim 6 is not obvious and is deemed allowable for the same reasons as claims 1 and 5, in addition to the additional subject matter recited therein.

Applicant respectfully requests withdrawal of this rejection.

**F. The Office Action rejects claim 7 under 35 U.S.C. §103(a) as allegedly being unpatentable over the Calton/Hoffman/Hinson/Fox/Bomes combination as applied against**

claim 6 above, and further in light of Official Notice. Applicant respectfully traverses the rejection.

The Office Action takes Official Notice that using a holder with openings such as a mesh holder within a container is conventional. Applicant respectfully submits that the alleged Official Notice does not overcomes the deficiencies of the alleged Calton/Hoffman/Hinson/Fox/Bomes combination. As such, applicant respectfully submits that claim 7 is not obvious and is deemed allowable for the same reasons as claim 1, in addition to the additional subject matter recited therein.

Applicant respectfully requests withdrawal of this rejection.

G. The Office Action rejects claim 8 under 35 U.S.C. §103(a) as allegedly being unpatentable over the Calton/Hoffman combination as applied against claim 1, and further in view of U.S. Patent 5,054,589 of Bomes. Applicant respectfully traverses the rejection.

As discussed above with regards to claim 6, Bomes is applied for merely suggesting inner liners 52 within a container to store additional content therein. Applicant respectfully submits that Bomes fails to overcome the deficiencies of the alleged Calton/Hoffman combination. Furthermore, applicant respectfully disagrees with the Office Action's characterization of Bomes item 52 as an invertible liner. It is not. Bomes describes item 52 as a "retaining flap" (see col. 3, lines 29 – 44). The retaining flap 52 has a mesh pocket. There is no illustration or suggestion that these retaining flaps can be inverted, i.e., turned inside out, or that there is any consideration that they be washable, or that they be impermeable. It would seem unlikely that a mesh pocket would be impermeable. Further

still, the Office Action has provided no substantive justification for the combination of the references. There is neither description, illustration, or suggestion in Bomes of pulling the mesh pocket inside out so that it can be washed.

This is perhaps not overly surprising. Bomes describes a suitcase for clothing. Since the general motivation for having an impermeable liner in a cooler, as indicated in the Background of the Invention of the present application at page 2, lines 8 to 12, is to catch, or contain, liquids that might otherwise be spilled in, or leak to, less benign locations. An invertible liner can be more easily washed to remove sticky liquids (colas, fruit juices, syrup) than one that is permanently held in place. A person skilled in the art would appreciate that would be improbable, if not infelicitous, to store liquids, such as a cold six-pack of beer, in one's suitcase with one's good clothes, let alone in a mesh pocket next to those clothes.

Finally, the Office Action has miscast the purpose of the liner. The addition of a liner does not permit the storage of additional content within the compartment. As noted above, the role of the liner is to contain liquids placed within the compartment. As such, applicant respectfully submits that claim 8 is not obvious and is deemed allowable for the same reasons as claim 1, in addition to the additional subject matter recited therein.

Applicant respectfully requests withdrawal of this rejection.

H. The Office Action rejects claim 10 under 35 U.S.C. §103(a) as allegedly being unpatentable over the Calton/Hoffman combination as applied against claim 1 above, and

further in light of U.S. Patent 4,192,365 of Siegel. Applicant respectfully traverses the rejection.

Siegel is applied merely for providing a key holder 150 to hold keys therein. Applicant respectfully submits that Siegel fails to overcome the deficiencies of the alleged Calton/Hoffman combination. As such, applicant respectfully submits that claim 10 is not obvious and is deemed allowable for the same reasons as claim 1, in addition to the additional subject matter recited therein.

Applicant respectfully requests withdrawal of this rejection

I. The Office Action rejects: a) claims 12, 18, 20 and 24 under 35 U.S.C. §102(b) as allegedly being anticipated by US Patent No. 4,673,117 to Calton, and b) claims 12, 15 and 16 under 35 U.S.C. §103(a) as allegedly being anticipated by US Patent No. 4,767,039 to Jacober in view of US patent No. 5,934,527 to Von Neumann. Applicant respectfully traverses both rejections.

In regards to la), claims 18 and 24 are canceled without prejudice or disclaimer. Thus the rejection to these two claims is rendered moot. In terms of claim 12, as discussed above, Calton fails to teach, suggest or disclose a flexible, soft-sided insulated wall structure. On the contrary, Calton's abstract refers to the impressive strength of Calton's cooler, such that it may be used as a chair.

To qualify as prior art under 35 U.S.C. §102, a single reference must teach, i.e., identically describe, each element of a rejected claim. Applicant respectfully submits that

the Calton patent fails to teach each and every element of claim 12. Accordingly, Calton does not anticipate claim 12. Thus, claim 12 is allowable.

Claim 20 depends from claim 12. it is respectfully submitted that this dependent claim is allowable over Calton for the reasons claim 12 is allowable, as well as for the additional subject matter recited therein.

As such, applicant respectfully requests withdrawal of this rejection.

In regards to Ib), Jacober discloses a backpack, and a removable insulated container. However, the backpack itself does not have a soft-sided insulated wall structure, and the container does not have a lifting member on a leading portion thereof, nor an auxiliary compartment mounted to a trailing portion thereof.

Even if Von Neumann is combined with the Jacober backpack, the addition of an auxiliary compartment to Jacober's insulated container would be counter-intuitive, since Jacober's insulated container appears to fit closely in the various pockets, and would seem to leave little space for accommodation of auxiliary pockets, or lifting members for that matter. Further, the Office Action has provided no explanation of why a person skilled in the art would be motivated to add an auxiliary compartment to Jacober's insulated container, given that Jacober indicates that the container is to be installed in a pocket, or pouch, and an auxiliary pocket mounted thereon would then be inaccessible.

Thus, the alleged Jacober/Von Neumann combination fails to teach or suggest a flexible soft-sided insulated container having a lifting member on a leading portion thereof

and an auxiliary compartment mounted to a trailing portion thereof. Accordingly, claim 12 is not obvious in view of the alleged combination and is deemed allowable.

Claims 15-16 depend from claim 12. It is respectfully submitted that these two dependent claims are allowable over the alleged Jacober/Von Neumann combination for the reasons claim 12 is allowable, as well as for the additional subject matter recited therein.

Applicant respectfully requests withdrawal of this rejection.

J. The Office Action rejects claims 13-14 under 35 U.S.C. §103(a) as allegedly being unpatentable over the alleged Jacober/Von Neumann combination as applied against claim 12 above, and also in light of U.S. Patent 3,001,566 of Lipsitz. Applicant respectfully traverses the rejection.

Jacob and Von Neumann are discussed above. Yet, the Office Action takes the position that Lipsitz shows, as items 8 and 9, reinforcements of the mountings. The applicant has identified the items referred to by the Office Action, but there is no indication of any purpose in Lipsitz that items 8 and 9 reinforce any of the mountings of Lipsitz' container. Lipsitz merely states "[b]ottom wall 3 is formed with upwardly extending end portions 8, 9 which overlap sidewalls 4, 5 respectively and are stitched thereto at 10, 11 as seen in FIGS. 1 and 3.". Further, as noted above, the alleged Jacober/Von Neumann combination, as well as Lipsitz, alone or in combination, fails to teach or suggest a pack having a soft-sided insulated wall structure that has a lifting member on the leading portion thereof and an auxiliary compartment mounted to the trailing portion thereof.

As such, applicant respectfully submits that claims 13-14 are not obvious and are deemed allowable for the same reasons as claim 12, in addition to the additional subject matter recited therein.

Applicant respectfully requests withdrawal of this rejection.

K. The Office Action rejects claims 16-17 under 35 U.S.C. §103(a) as allegedly being unpatentable over the alleged Jacober/Von Neumann combination as applied against claim 12 above, and Official Notice. Applicant respectfully traverses the rejection.

The Office Action takes Official Notice that the use of reinforcements on a bag to strengthen a certain portion of the bag is conventional.

Applicant respectfully submits that the alleged Official Notice does not overcome the deficiencies of the alleged Jacober/Von Neumann combination. As such, applicant respectfully submits that claims 16-17 are not obvious and are deemed allowable for the same reasons as claim 12, in addition to the additional subject matter recited therein.

Applicant respectfully requests withdrawal of this rejection.

L. The Office Action rejects claim 19 under 35 U.S.C. §103(a) as allegedly being unpatentable over Calton, Hinson, and Fox. Applicant respectfully traverses the rejection.

Calton, Hinson and Fox are discussed above. Yet, the Office Action applies Hinson merely for allegedly teaching an outer covering for the lid portion of a container while Fox merely shows a handle 17 on a lid portion of the container. Applicant respectfully submits that Hinson and Fox fail to overcome the deficiencies of Calton and provide no motivation for their alleged combination and/or modification. Accordingly, claim 19 is not obvious and

is deemed allowable for its dependency on allowable base claim 12, as well as the additional subject matter recited therein.

Applicant respectfully requests withdrawal of this rejection.

M. The Office Action rejects claim 21 under 35 U.S.C. §103(a) as allegedly being unpatentable over the alleged Calton/Hoffman combination applied above against claim 1, and further in view of U.S. Patent 4,378,866 to Pelavin and 5,288,150 to Bearman. Applicant respectfully traverses the rejection.

As discussed above in the remarks pertaining to claim 1, neither Calton or Hoffman, alone or in combination, teach or suggest a flexible, soft-sided insulated wall structure. Pelavin is applied merely for suggesting a slanted pocket on a side portion of the container to store equipment therein while Bearman is applied for allegedly suggesting see-through pockets on a tote bag. Applicant respectfully submits that neither Pelavin or Bearman overcome the deficiencies of the alleged Calton/Hoffman combination. As such, applicant respectfully submits that claims 4 and 11 are not obvious and are deemed allowable for the same reasons as claim 1, in addition to the additional subject matter recited therein.

Applicant respectfully requests withdrawal of this rejection.

N. The Office Action rejects claim 22 under 35 U.S.C. §103(a) as allegedly being unpatentable over Calton in view of Bomes. As claim 22 is cancelled without prejudice or disclaimer, this rejection is rendered moot.

O. The Office Action rejects claim 23 under 35 U.S.C. §103(a) as allegedly being unpatentable over Calton in view of Pelavin and Bearman and Bomes. As claim 23 is cancelled without prejudice or disclaimer, this rejection is rendered moot.

**Conclusion**

In view of the foregoing, reconsideration of the application, withdrawal of the outstanding rejections, allowance of claims 1-17 and 19-21, and the prompt issuance of a Notice of Allowability is respectfully solicited.

Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone listed below.

U. S. Patent Application No. 09/122,088

In the event this paper is not considered to be timely filed, the Applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300.

Respectfully submitted,  
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Enclosure: Petition for Extension of Time

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